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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellate No. : 10/720,948 Confirmation No. 5271
Appellant : Paul R. Gagnon
Filed : November 24, 2003
TC/A.U. : 3711
Examiner : Mitra Aryanpour

Docket No. : 03-482
Customer No. : 34704

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

REPLY BRIEF

Sir:

This is in response to the Examiner's Answer mailed
December 8, 2005.

REMARKS/ARGUMENTS

(A) Neither Maged nor Micchia
Disclose The Claimed Thickness Limitation

A claim is anticipated when the same device or method, having all the elements contained in the claim limitations, is described in a single prior art reference. See *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). An anticipating reference must describe the claimed subject matter with sufficient clarity and detail to establish that the subject matter existed in the prior art and that such existence would be recognized by persons of ordinary skill in the field of the invention. See *In re Spada*, 911 F. 2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); also see *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988). The Examiner's response concerning the

Maged nor Micchia et al. patents set out on page 7 and 8 of the Examiner's Answer misses the point that neither Maged nor Micchia et al. describe the claimed subject matter with sufficient clarity and detail to establish that the subject matter existed in the prior art and that such existence would be recognized by persons of ordinary skill in the field of the invention. As a result, neither is an anticipating reference.

The Examiner contends that the claims as presented do not require the material to have a specific thickness. This statement is patently wrong. Claim 1 clearly calls for the piece of material to have "a thickness sufficient to interfere with an individual's ability to look in a specific direction at a sporting object being controlled by the individual." Independent claims 10 and 18 include a similar thickness limitation. The fact that the claims do not include a thickness in a specific range is entirely irrelevant to the issue of whether Maged or Micchia et al. anticipate the claimed invention.

Claims 1 and 18 also point out that the material has to be positioned so that the piece of material interferes with the individual's ability to look at the sporting object.

The Examiner totally ignores the latter point about the positioning of the material and focuses solely on the issue of thickness. In the rejection and in the response to the arguments section, the Examiner makes the conclusory statement that both references show the material to have sufficient thickness to interfere with an individual's ability to look in a specific direction at an object such as a sporting object. In support of this conclusory statement, the Examiner relies upon the drawings of the references. The Examiner, in the response to argument section, then goes on to say that since no specific thickness has been claimed, then the thickness of the material in both the

Maged and Micchia et al. patent can be considered "sufficient" to interfere with the user's ability to look in a specific direction. The Examiner takes this position despite the fact that a thickness has been claimed and despite the fact that at least the cited reference to Maged disproves the conclusory statement that the thickness is sufficient to interfere with the user's ability to look in a different direction.

The Maged reference is crystal clear that the tape members, who have a thickness, are placed in a position where it not visible to the wearer. On page 4, lines 18 - 26, Maged says that his invention provides a greater improvement in respiratory ease while avoiding having the tape members being partially visible and annoying to wearers. This portion of the reference clearly shows: (1) that Maged does not anticipate the subject matter of claim 1; and (2) that the Examiner's conclusory statement about thickness is wrong. The fact that a piece of material has a thickness does not necessarily mean that it would interfere with someone's vision.

Maged also clearly demonstrates that the Examiner's statement that "any material positioned under the eyes will cause some degree of interference with the field of vision," Maged's material is positioned under the eye and does not interfere with the user's field of vision at all.

The Micchia et al. patent is totally silent on the issue of thickness other than to say that the patches are "thin". See column 3, line 43 of Micchia et al. Thus, one can not conclude that the Micchia et al. patent discloses either the claimed thickness limitations of claims 1, 10, and 18 and/or the claimed positioning limitations of claims 1 and 18. With regard to the Examiner's contention that the claimed thickness limitation can be found in column 2, lines 14 - 45, this contention is wrong.

This section does not say anything about providing a patch with a thickness sufficient to interfere with individual's ability to look in a specific direction at a sporting object. With regard to the Examiner's comments about FIG. 2 in Micchia et al., there is no discussion as to how this figure shows that the material has a thickness sufficient to inherently direct the individual's vision up and toward the field of play. The figure is nothing more than a cross sectional view of the patch.

It is the Examiner's burden to provide evidentiary support for the conclusory statements made both in the rejection and in the response to the argument. See *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967). As with the inherency argument presented by the Examiner, there has been no evidentiary support provided by the Examiner that all of the claimed features are necessarily present in the Micchia et al. and/or Maged references and that one of skill in the art would recognize them as being necessarily present.

With regard to the Examiner's comments about the term "sufficient" beginning at the bottom of page 7 and extending onto page 8 of the Examiner's Answer, the Examiner's arguments make no sense to Appellant. The limitation "a thickness sufficient to interfere with an individual's ability to look in a specific direction ..." in claim 1, as well as the thickness limitations in claims 10 and 16, call for there to be a thickness which carries out the stated function(s). Thus, the word "sufficient", when read in its context, and in light of the specification, would be readily understood by those of skill in the art.

On page 8, the Examiner makes the statement that "... to reach the conclusion that neither patent has the same thickness because it hasn't been expressly disclosed is not persuasive

since it is speculative and is not supported by any objective evidence." The Examiner then cites *In re De Blauwe*, 736 F.2d 699, 705, 222 USPQ 191, 196 (Fed. Cir. 1984); and *In re Linder*, 457 F.2d 506, 508, 173 USPQ 356, 358 (CCPA 1972) in support of this proposition.

With regard to the proposition itself, the conclusion that neither patent does not expressly disclose the claimed invention arises out of the express language of the patent. The Examiner can point to no portion in either reference which states that the thickness of the articles described in the patent meets the claimed thickness limitation. In fact, as noted above, the Maged patent expressly disavows the claimed invention. Further, it is true that a reference does not have to expressly disclose the claimed limitations. The claimed limitations could be inherently present. The problem is that the Examiner has not made a showing that the claim limitations are inherently present in the cited and applied references. In fact, the Examiner can not make such a showing because Maged clearly demonstrates that a piece of material can have a thickness and still not block a wearer's vision.

As for the *De Blauwe* and *Lindner* cases relied upon by the Examiner, neither of these cases has anything to do with anticipation and/or the law of inherency. The rejection in the *De Blauwe* case is an obviousness rejection. *De Blauwe* attempts to overcome the obviousness rejection by arguing unexpected results. The Court says that mere argument or conclusory statements in the specification of the application do not suffice. The Court does not discuss the effect of the absence of certain statements in a cited and applied reference. The *Lindner* case is also an obviousness case. It too involves an unexpected results argument. Here, the CCPA states that mere conclusory

statements in the specification of the application and affidavits are entitled to little weight when the Patent Office questions the efficacy of those statements. The opinion says nothing about the effect of the absence of certain statements in a cited and applied reference. Thus, these cases do not support the argument which the Examiner attempts to make.

CONCLUSION

For the reasons set forth herein and for the reasons set forth in Appellant's Brief, the rejection of claims 1 - 18 should be reversed and the application should be remanded to the Examiner for allowance and issuance.

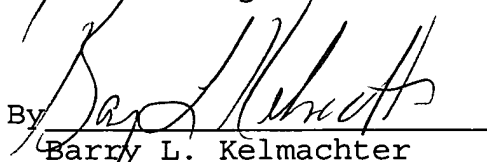
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No fee is believed to be due as a result of this response. Should the Director determine that a fee is due, he is hereby authorized to charge said fee to Deposit Account No. 02-0184.

Respectfully submitted,

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IN TRIPLICATE

Date: February 7, 2006

I, Nicole Motzer, hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313" on February 7, 2006.

